

Appl. No. 10/087,697
Reply to Office Action of February 9, 2005

Remarks

Introduction

Claims 2-4, 6-16, 18-25, and 28-33 remain pending.

Rejections Under 35 U.S.C. § 103

Claims 2-4, 6-16, 18-25, 28-29, and 31-33 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kennedy et al. (U.S. Patent No. 6,523,954; hereinafter Kennedy) in view of Peifer et al. (U.S. Patent No. 6,112,224; hereinafter Peifer), and further in view of Lloyd et al. (U.S. Patent No. 6,080,106; hereinafter Lloyd). Claims 2-4, 6-16, 18-25, 28-29, and 31-33 have also been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peifer in view of Kennedy, and further in view of Lloyd.

Applicant traverses the rejections as they relate to the present claims.

Applicant submits that a *prima facie* case of obviousness has not been established because the relied upon references and relied upon combinations of references (Kennedy, Peifer, and Lloyd or Peifer, Kennedy, and Lloyd) fail to disclose, teach, or suggest all of the elements recited in the present claims. For example, the references, taken alone or in any combination, do not disclose, teach, or even suggest a telemedicine system or method which includes a diagnostic center remotely located from a remote exam module for directing examination of a patient's eye and which comprises a database and an exam console for displaying information to an eye care practitioner located at

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the diagnostic center for analysis, as recited in the present claims.

Applicant maintains and resubmits that Kennedy does not disclose, teach, or even suggest a system comprising a diagnostic center that comprises an exam console for displaying transmitted information, such as graphics and/or text, corresponding to the collected information to an eye care practitioner located at the diagnostic center for analysis of the information, as recited in the present claims. The Examiner appears to have completely disregarded this important distinction, which was presented in applicant's previous response, since the Office Action simply states that Kennedy discloses "means for displaying the images for skilled specialists" (page 2, paragraph 4).

Applicant resubmits that Kennedy discloses a system and method for screening an eye that includes one or more remotely located reading centers or readers 208, 210, 212 (col. 7, lines 40-43; and FIG. 7). Readers are individuals that are trained to view images of patient's eyes and evaluate those images for signs of disease, abnormalities, or impaired vision (col. 9, lines 56-60). Importantly, the readers are remotely located from the central analysis facility 200, which might be considered analagous to the presently claimed diagnostic center. In other words, the central analysis facility or diagnostic center of Kennedy does not include, and does not even suggest, an exam console that displays information to a reader located at the central analysis facility. This is in direct contrast to the systems and methods recited in the present claims.

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As discussed above, Kennedy specifically discloses that the central analysis facility, which includes a database, transmits the ophthalmic or eye exam information to a reader that is remotely located from the central analysis facility. In other words, Kennedy clearly discloses that the central analysis facility does not comprise an exam console that displays graphics and/or text-based information to an eye care practitioner located at the central analysis facility.

Applicant submits that Kennedy actually teaches clearly, directly, and expressly away from the presently claimed systems and methods since Kennedy specifically teaches that the reader, or eye care practitioner, is at a location remote from the central analysis facility or diagnostic center. Indeed, Kennedy discloses the importance of having readers remotely located from the central analysis facility to permit the Kennedy system to select certain readers based on a number of selection criteria. "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

Applicant submits that Kennedy is in direct contrast to and teaches away from the present invention in which the eye care practitioner is located at the diagnostic center, as recited in the present claims.

Peifer discloses a patient monitoring system for use in telemedicine. The monitoring system disclosed by Peifer includes non-ophthalmic medical devices, such as blood pressure devices, thermometers, pulse oximetry devices, electrocardiograms, scales, and stethoscopes (column 4, lines

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34-38). The monitoring system of Peifer includes monitoring stations remotely located from the medical devices. Importantly, the monitoring stations only permit a health care professional to receive or obtain information from the patient (column 3, lines 45-47). In short, Peifer discloses a system in which a health care professional can monitor a patient using non-ophthalmic medical devices without being able to direct an eye examination and analyze information from the eye examination.

Importantly, Peifer does not disclose, teach, or even suggest a system or method which comprises at least one remote exam module comprising a plurality of eye examination devices, as recited in the present claims. In contrast, all of the medical devices disclosed by Peifer are not eye examination devices. Peifer does not include any suggestion or motivation whatsoever to include one or more eye examination devices.

Furthermore, Peifer does not disclose, teach, or even suggest a diagnostic center for directing the examination of an eye and analyzing collected information of the eye examination, as recited in the present claims. In direct contrast, the system and methods disclosed by Peifer only monitor a patient. Peifer does not disclose, teach, or even suggest any diagnostic capabilities of the system. Moreover, Peifer does not disclose, teach, or even suggest a diagnostic center that comprises a database and an exam console for displaying information to an eye care practitioner located at the diagnostic center, as recited in the present claims.

In short, Peifer fails to disclose, teach, or even suggest all of the elements of the present claims. Furthermore, Peifer

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fails to provide the deficiencies apparent in Kennedy. For example, even if Peifer could be erroneously combined with Kennedy, the combination of Peifer and Kennedy does not disclose, teach, or even suggest a telemedicine system and method which comprise a diagnostic center, as recited in the present claims, let alone, a diagnostic center that comprises an exam console for displaying information to an eye care practitioner located at the diagnostic center.

Lloyd does not disclose, teach, or suggest the present invention. For example, Lloyd does not disclose, teach, or even suggest a telemedicine system that comprises at least one remote exam module comprising a plurality of eye examination devices, and a diagnostic center for directing the examination of an eye of a patient, as recited in the present claims.

Similar to Peifer, Lloyd discloses a patient monitoring system (column 1, line 5). The system collects and transfers data from a patient to a remote monitoring system (column 2, lines 56-57). As specifically shown in FIG. 1, the remote monitoring system is used by a monitoring staff (70), which is specifically illustrated as a cardiac nurse. As understood by persons of ordinary skill in the art, nurses cannot provide medical diagnoses of patients. As disclosed by Lloyd, the monitoring staff 70 can provide additional questions for a patient to answer in connection with the patient monitoring, and the answers to the questions can be provided to a different physician (column 7, lines 20-25 and 59-65; and FIG. 1).

Importantly, Lloyd does not disclose, teach, or even suggest a system or method which comprises at least one remote exam module comprising a plurality of eye examination devices,

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as recited in the present claims. In contrast, Lloyd emphasizes that the system is particularly useful in remote monitoring of cardiac associated diseases. Lloyd does not even suggest monitoring ocular conditions, let alone diagnosing ocular conditions, as in the presently claimed invention. Moreover, Lloyd does not include any suggestion or motivation to include one or more eye examination devices.

Furthermore, Lloyd does not disclose, teach, or even suggest a diagnostic center for directing the examination of an eye and analyzing collected information of the eye examination, as recited in the present claims. In direct contrast, the system and methods disclosed by Lloyd only monitor a patient. Lloyd does not disclose, teach, or even suggest any diagnostic capabilities of the system. Moreover, Lloyd does not disclose, teach, or even suggest a diagnostic center that comprises a database and an exam console for displaying information to an eye care practitioner located at the diagnostic center, as recited in the present claims. In contrast, Lloyd actually teaches away from the present claims since the monitoring staff that is located at the monitoring station is a nurse that cannot make diagnoses.

In short, Lloyd fails to disclose, teach, or even suggest all of the elements of the present claims. Furthermore, Lloyd fails to provide the deficiencies apparent Kennedy and/or Peifer. For example, even if Lloyd could be erroneously combined with Kennedy and/or Peifer, any combination of Lloyd, Kennedy, and Peifer does not disclose, teach, or even suggest a telemedicine system and method which comprise a diagnostic center, as recited in the present claims, let alone, a diagnostic center that comprises an exam console for displaying

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information to an eye care practitioner located at the diagnostic center.

Applicant submits that Kennedy and/or Peifer, and/or Lloyd provide no motivation whatsoever to a person of ordinary skill in the art to combine the teachings of Kennedy and the teachings of Peifer and the teachings of Lloyd in any manner because their respective systems are substantially different and distinct, one from the other. As discussed above, the system disclosed by Kennedy requires transmission of eye exam data from a central analysis facility to remotely located readers to provide a diagnosis of the eye exam. In contrast, each of the systems disclosed by Peifer and Lloyd are directed to non-ophthalmic monitoring systems. The teachings of Peifer and Lloyd do not even suggest any diagnostic center, let alone a diagnostic center which transmits data to remote readers, as disclosed by Kennedy. Thus, applicant submits that a person of ordinary skill in the art would not be motivated to combine Kennedy, Peifer, and Lloyd, let alone to do so, and obtain the claimed invention.

Furthermore, applicant submits that a person of ordinary skill in the art would not be motivated to combine the teachings of Peifer and Lloyd with Kennedy since combining the references would require a person to use the non-ophthalmic medical devices disclosed in Peifer and Lloyd in the ophthalmic system disclosed by Kennedy. It is well settled that "a reference must be interpreted as a whole, and cannot be picked apart to deprecate an invention (*In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988)). Applicant submits that when the references are interpreted as a whole, a person of ordinary skill in the art would clearly not be motivated to combine the teachings of

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Peifer and Lloyd with Kennedy in any manner since the systems include entirely different and distinct medical devices, and are used for different and distinct purposes. Only after knowing of applicant's invention and disclosure would one of ordinary skill in the art even consider modifying and extending the deficient teachings of Kennedy, Peifer, and Lloyd. Such hindsight reconstruction of the prior art based on applicant's own invention and disclosure is an improper basis for rejecting patent claims.

Moreover, even if the teachings of Kennedy, Peifer, and Lloyd could be erroneously combined, the combination fails to disclose, teach, or even suggest all of the limitations of the present claims. For example, as discussed above, the combination of Kennedy, Peifer, and Lloyd fails to disclose, teach, or even suggest a system that comprises a diagnostic center which comprises an exam console for displaying transmitted information corresponding to the collected information to an eye care practitioner located at the diagnostic center for analysis of the information, as recited in the present claims. Thus, applicant submits that the combination of Kennedy, Peifer, and Lloyd does not disclose, teach, or even suggest all of the elements of the present claims.

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present system and method including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

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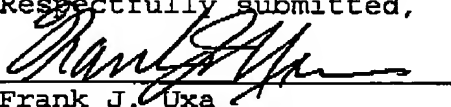
In view of the above, applicant submits that the present claims, that is claims 2-4, 6-16, 18-25, and 28-32, are unobvious from and patentable over Kennedy, Peifer, and Lloyd, taken alone or in any combination, under 35 U.S.C. § 103.

Conclusion

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35 U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 2-4, 6-16, 18-25, and 28-33, are allowable. Therefore, applicant respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Date: 5/9/05

Respectfully submitted,


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